



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 09/463,681 | 01/31/00 | BLUM | J PM266043 |

IM22/1218

CUSHMAN DARBY & CUSHMAN
PILLSBURY MADISON SUTRO
1100 NEW YORK AVENUE NW
NINTH FLOOR EAST TOWER
WASHINGTON DC 20005-3918

EXAMINER

MAYEKAR, K

ART UNIT

PAPER NUMBER

1741

DATE MAILED:

12/18/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/463,681

Applicant(s)
J. Blum et al.

Examiner
Kishor Mayekar

Group Art Unit
1741



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-10 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-10 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1741

DETAILED ACTION

Claim Rejections - 35 U.S.C. § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 8 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 8, it is indefinite because the subject matter after "comprising" is not a process step.

Regarding claim 10, the claim is confusing because the claim is directed to a product while it depends on a process claim (claim 1).

Art Unit: 1741

Claim Rejections - 35 U.S.C. § 102 or § 103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 9 and 10 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by STROMBERG (3,674,671). STROMBERG's invention is directed to the formation of "black iron-oxide-containing coatings when deposited on solid substrates

Art Unit: 1741

and cured exhibit sufficient electrical conductivity to permit application of a top coat by electrodeposition" (see abstract). STROMBERG further discloses that the process comprises all the steps as claimed and that the black iron-oxide coating is deposited by electrodeposition or by other means such as dipping (Examples ; col. 1, lines 37-50 and lines 64-71; col. 2, lines 62-66; and Example 1). Because STROMBERG discloses that at least one of the top coatings being applied by electrodeposition and the resin used in the top coatings are synthetic resin which forms thermosetting coatings, the top coatings are plastic coatings.

6. Claims 1-4, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over STROMBERG '671 in view of Applicant's admission. STROMBERG is applied as above except for the application of a plastic film over the topcoat. However, Applicant admits in the Background of the Invention that the above application is known. The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the reference's

Art Unit: 1741

teachings as admitted by Applicant because the provision of the above application is known.

7. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over MATSUO et al. (5,190,830) in view of Applicant's admission. MATSUO's invention is directed to a method of forming a uniform coating by electrodeposition on integrated ferrous and non-ferrous materials and product thereof. MATSUO discloses that the method comprises all the steps as claimed (col. 2, lines 21-32; col.3, line 65 through col. 4, line 13; col. 4, lines 42-52; and Examples). The difference between MATSUO and the instant claims is the application of a plastic film over the coatings. However, Applicant admits in the Background of the Invention that the above application is known. The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the reference's teachings as admitted by Applicant because the provision of the above application is known.

Art Unit: 1741

8. Claims 1, 3-4 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over RICHARDSON (5,203,975) in view of Applicant's admission. RICHARDSON's invention, a reference cited by Applicant, is directed to a process for cathodic electrodeposition of a clear coating over a conductive paint layer. In the paragraph crossing cols. 1 and 2, RICHARDSON discloses the advantage of applying a clear topcoat by electrodeposition over spray applied clear topcoats. In the abstract, RICHARDSON discloses that the process comprises all the steps as claimed except for the application of a plastic film over the clear topcoat. However, Applicant admits in the Background of the Invention that the above application is known. The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the reference's teachings as admitted by Applicant because the provision of the above application is known.

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over STROMBERG '671 alone or as modified with Applicant's admission as applied to claims 1-4, 9 and 10 above, and further in view of either MATSUO '830 or

Art Unit: 1741

RICHARDSON '975. The difference between the reference(s) applied above and the instant claim is that the process is for coating motor vehicles or the components thereof. MATSUO or RICHARDSON as applied above shows the use for coating motor vehicles. The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the reference's teachings alone or as modified by Applicant's admission because the selection of the material to be used for coatings would have been within the level of ordinary skill in the art.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. HIRAKI et al. (4,983,454) shows in a process for coating metallic substrate that all the coatings are applied with or without spraying.

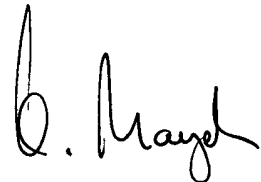
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kishor Mayekar whose telephone number is (703) 308-

Art Unit: 1741

0477. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathryn Gorgos, can be reached on (703) 308-3328. The fax phone number for this Group is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.



Kishor Mayekar
Primary Examiner
Group 1700

KM

December 14, 2000